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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/670,338

09/26/2003

Masatoshi Yamada

117336

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06/01/2006

OLIFF & BERRIDGE, PLC
P.O. BOX 19928
ALEXANDRIA, VA 22320

EXAMINER

MORRISON, THOMAS A

ART UNIT

PAPER NUMBER

3653

DATE MAILED: 06/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/670,338

Applicant(s)

YAMADA ET AL.

Examiner

Thomas A. Morrison

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-13 and 19 is/are allowed.
- 6) ☒ Claim(s) 14-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 02/02/2006.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Claim 1 is generic and allowable. Accordingly, the restriction requirement as to the encompassed species is hereby withdrawn and claims 5-6, directed to the species of Figs. 13-14 are no longer withdrawn from consideration since all of the claims to this species depend from or otherwise include each of the limitations of an allowed generic claim.

In view of the above noted withdrawal of the restriction requirement as to the linked species, applicant(s) are advised that if any claim(s) depending from or including all the limitations of the allowable generic linking claim(s) be presented in a continuation or divisional application, such claims may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Claim Objections

2. Claims 14-18 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. It is unclear how the storage medium set forth in claims 14-18 further limits the subject matter of the claims from which these claims depend. Claims 14-18 fail the infringement test, because dependent claims 14-18 can be infringed without the basic claims (i.e, the claims from which they depend) being infringed. Thus, claims 14-18 are improper dependent claims. See, e.g., MPEP, section 608.01(n).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 14-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 14, it is unclear what control program or what specific process steps are being claimed. For example, claim 4 recites a change detection device to detect a change in an open/closed state of the manual feed tray. It is unclear if the control program of claim 14 is limited to this process step.

Similarly, with regard to claims 15-18, it is unclear what control program or what specific process steps are being claimed in each of these claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 14-18 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,385,335 (Kierner).

Regarding claim 14, Fig. 3 shows a storage medium (11) *for storing control program to achieve the functions of the change detection device and the control device of the paper feeding apparatus according to claim 4 by a computer processing.* See,

e.g. column 3, lines 55-58 for disclosure about storing programs. The italicized portion above after the word “for” is merely a statement of intended use. As such, it has not been given patentable weight.

Regarding claim 15, Fig. 3 shows a storage medium *for storing control program to achieve the functions of the paper detection device, opening/closing detection device and the first annunciation device of the image formation according to claim 10 by a computer processing*. See, e.g. column 3, lines 55-58 for disclosure about storing programs. Again, the italicized portion above after the word “for” is merely a statement of intended use. As such, it has not been given patentable weight.

Regarding claim 16, Fig. 3 shows a storage medium (11) *for storing control program to achieve the functions of the paper detection device, the opening/closing detection device and the second annunciation device of the image formation according to claim 11 by a computer processing*. See, e.g. column 3, lines 55-58 for disclosure about storing programs. Once again, the italicized portion above after the word “for” is merely a statement of intended use. As such, it has not been given patentable weight.

Regarding claim 17, Fig. 3 shows a storage medium (11) *for storing control program to achieve the functions of the paper detection device, the opening/closing detection device, the third annunciation device and the feed control device of the image formation apparatus according to claim 12 by a computer processing*. See, e.g. column 3, lines 55-58 for disclosure about storing programs. Again, the italicized portion above

after the word "for" is merely a statement of intended use. As such, it has not been given patentable weight.

Regarding claim 18, Fig. 3 shows a storage medium (11) *for storing control program to achieve the functions of the change detection device, the preprocess execution device and the feed control device of the image formation according to claim 13 by a computer processing.* See, e.g. column 3, lines 55-58 for disclosure about storing programs. The italicized portion above after the word "for" is merely a statement of intended use. As such, it has not been given patentable weight.

Allowable Subject Matter

5. Claims 1-13 and 19 are allowed.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Morrison whose telephone number is (571) 272-7221. The examiner can normally be reached on M-F, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Crawford can be reached on (571) 272-6911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

05/29/2006

Joseph R. Rader
JRR 5/29/06